

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Kobi Iki et al.	Art Unit :	3739
Patent No. :	7,951,142	Examiner :	Michael F. Peffley
Issue Date :	May 31, 2011	Conf. No. :	4190
Serial No. :	10/766,894		
Filed :	January 30, 2004		
Title :	CARTILAGE TREATMENT PROBE		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentees hereby request reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 944 days to 1,017 days is respectfully requested.

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. Patentees respectfully submit that the Office did not apply the proper standard for determining the period of “B Delay” under 35 U.S.C. § 154(b)(1)(B).

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

Applicant Delay

Patentees filed an Information Disclosure Statement on July 18, 2006, subsequent to a reply filed on June 5, 2006. Patentees were accorded a delay of 43 days for a supplemental response. Patentees do not dispute the PTO’s calculation for this Applicant Delay from June 6, 2006, to July 18, 2006. See 37 C.F.R. § 1.704(c)(8).

A reply to an Office Action was due on or before February 17, 2009 (the date that is three months after November 17, 2008, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on February 26, 2009, thereby according an Applicant Delay of 9 days. Patentees do not dispute the PTO’s calculation for this Applicant Delay from February 18, 2009 (the day after the date that is three months after the date on which the Office Action was mailed), to February 26, 2009. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before November 21, 2009 (the date that is three months after August 21, 2009, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on November 23, 2009, thereby according an Applicant Delay of 2 days. Patentees do not dispute the PTO's calculation for this Applicant Delay from November 22, 2009 (the day after the date that is three months after the date on which the Office Action was mailed), to November 23, 2009. See 37 C.F.R. § 1.704(b).

Patentees filed an Information Disclosure Statement on January 20, 2010, subsequent to a reply filed on November 23, 2009. Patentees were accorded 0 days delay for a supplemental response. In good faith and candor, Patentees submit that the supplemental response should have been accorded a total Applicant Delay of 58 days for delay from November 24, 2009, to January 20, 2010. See 37 C.F.R. § 1.704(c)(8).

In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 112 days (i.e., the sum of 43 days, 9 days, 2 days, and 58 days).

"A Delay"

A first PTO action was due on or before March 30, 2005 (the date that is fourteen months after January 30, 2004, the date on which the application was filed). The PTO mailed the first non-final Office Action on May 9, 2006, thereby according a PTO Delay of 405 days. Patentees do not dispute the PTO's calculation for this "A Delay" from March 31, 2005 (the day after the date that is fourteen months after the date on which the application was filed), to May 9, 2006. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

A PTO action was due on or before December 7, 2007 (the date that is four months after August 7, 2007, the date on which a response to Office Action was filed). The PTO mailed a non-final Office Action on November 17, 2008, thereby according a PTO Delay of 346 days. Patentees do not dispute the PTO's calculation for this "A Delay" from December 8, 2007 (the day after the date that is four months after the date on which a response to Office Action was filed), to November 17, 2008. See 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2).

A PTO action was due on or before June 26, 2009 (the date that is four months after February 26, 2009, the date on which a response to Office Action was filed). The PTO mailed a final Office Action on August 21, 2009, thereby according a PTO Delay of 56 days. Patentees do not dispute the PTO's calculation for this "A Delay" from June 27, 2009 (the day after the date that is four months after the date on which a response to Office Action was filed), to August 21, 2009. See 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2).

A PTO action was due on or before March 23, 2010 (the date that is four months after November 23, 2009, the date on which a response to Office Action was filed). The PTO mailed a non-final Office Action on July 7, 2010, thereby according a PTO Delay of 106 days. Patentees do not dispute the PTO's calculation for this "A Delay" from March 24, 2010 (the day after the date that is four months after the date on which a response to Office Action was filed), to July 7, 2010. See 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2).

In view of the periods of "A Delay" detailed above, the total "A Delay" for this patent should be calculated as 913 days (i.e., the sum of 405 days, 346 days, 56 days, and 106 days).

"B Delay"

There is no dispute that the Office failed to issue a patent within three years of the filing date of the application and that Patentees are entitled to "B Delay" to compensate for that Office delay. The only issue in contention is the correct length of the "B Delay" period.

The period beginning on January 31, 2007 (the day after the date that is three years after the date on which the application was filed), and ending May 31, 2011 (the date the patent was issued), is 1,582 days in length. The "PTA 36 Months" entry in the PAIR/PALM system indicates that a total of 85 days were awarded for "B Delay" for this patent. Patentees respectfully submit that the PTO's calculation of this "B Delay" is incorrect.

Section 154(b)(1)(B)(i) of Title 35 excludes from the calculation of "B Delay" "any time consumed by continued examination of the application." In the present matter, Requests for Continued Examination were filed on April 26, 2007, and November 23, 2009. The Director erred in the calculation of patent term adjustment by subtracting from "B Delay" a period of time that was not "consumed by continued examination of the application." The PTO mailed a Notice

of Allowance on January 21, 2011, thereby closing examination of the application on that date. Thus, no continued examination took place during the 131 day period from January 21, 2011 (the mailing date of the Notice of Allowance), until May 31, 2011 (the date the patent was issued). Accordingly, 131 days of "B Delay" should have been included in addition to the 85 days accorded by the Director, for a total "B Delay" of 216 days. Patentees respectfully submit that the Office's calculation of "B Delay" is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 216 days.

Overlap of "A Delay" and "B Delay"

As detailed above, 913 days of "A Delay" accumulated during the following periods:

March 31, 2005, to May 9, 2006;
December 8, 2007, to November 17, 2008;
June 26, 2009, to August 21, 2009; and
March 24, 2010, to July 7, 2010.

As detailed above, 216 days of "B Delay" accumulated during the following periods:

January 31, 2007, to April 26, 2007; and
January 21, 2011, to May 31, 2011.

As such, the periods of "A Delay" and "B Delay" do not overlap (i.e., occur on the same calendar day).

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

Conclusion

In consideration of the events described above, Patentees believe the PTA calculation of 944 days is incorrect. As such, Patentees respectfully request reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 1,129 days (i.e., the sum of 913 days of "A Delay" and 216 days of "B Delay");
- 2) Total Applicant Delay should be calculated as 112 days; and

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3) Total PTA should be calculated as 1,017 days.

The \$200 fee required under 37 C.F.R. § 1.18(e) is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other credits or charges to Deposit Account No. 06-1050, referencing Attorney Docket No. 00167-0491001.

Respectfully submitted,

Date: August 1, 2011

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